



UNITED STATES PATENT AND TRADEMARK OFFICE

Handwritten signature/initials

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,935	04/21/2004	David G. Gorenstein	UTMB:1024	5115

7590 06/07/2006

CHALKER FLORES, LLP
Suite 1036
2711 LBJ Freeway
Dallas, TX 75234

EXAMINER

WESSENDORF, TERESA D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/828,935	Applicant(s) GORENSTEIN ET AL.	
	Examiner T. D. Wessendorf	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final *for restriction only*.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-81 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29, drawn to a method of isolating a target, classified in class 435, subclass 6+.
- II. Claims 30-61, drawn to a method for aptamer selection, classified in class 435, subclass 7.1.
- III. Claims 62-81, drawn to a system (apparatus), classified in class 436, subclass 173+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to different methods comprising different steps and/or components with different results and/or effects. For example, the method of Group I relates to a method of isolating target using one or more probe beads. Group II relates to the selection of an

Art Unit: 1639

aptamer from one bead combinatorial library i.e., a screening process.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different processes such as selecting for aptamers or other small peptides or library of peptides or the process can be practiced by another and materially different apparatus or by hand as in claim e.g., 26.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, the inventions require a different field of search (see MPEP § 808.02), especially the literature journal search and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1639

Claims 1, 5-6, 10, 12, 13, 14, 25-27, 30, 35, 39-40, 43, 46, 47, 52, 56, 59-61, 62, 67, 71, 74, 78 and 80 are generic to the following disclosed patentably distinct species:

If Group I is elected, applicants are to elect a single species from each of the following subgroups (i.e., one species from A, one from B and so on.)

A. Probe beads library:

1. S-ODN library
2. S2-ODN

B. Probe (as recited in e.g., claim 10):

1. Aptamer-thioaptamer
2. DNA
3. RNA
4. PNA
5. Peptide
6. Antibody
7. Cell
8. Cell fragment
9. Carbohydrate
10. Lipid
11. Combinations (need to recite the specific combination).

- C. Linkages as recited in e.g., claim 12.
- D. Label for the target as recited in e.g., claim 13.
- E. Means of analysis as recited in e.g., claim 18.
- F. Thixotrophic agent as recited in e.g., claim 25.
- G. Selecting or picking means as recited in e.g., claim 26.
- H. Target as recited in e.g., claim 27.

If Group II or III is elected, applicants are required to elect a single species from each of the following subgroups as follows:

Subgroups A and C-H as given above.

I. Matrix, if thixotropic agent is selected, the species are as recited in F above.

J. Attachment of fluorophors as recited in claim 43.

The species are independent or distinct because each of the compounds recited in e.g., subgroup B differs in structure, mode of action and function. A prior art reference anticipating one species would not render obvious the other species in that subgroups e.g., B subgroup.

Applicant(s) is/are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant(s) is/are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant(s) will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant(s) must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant(s) traverse on the ground that the species are not patentably distinct, applicant(s) should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Application/Control Number: 10/828,935
Art Unit: 1639

Page 7

Applicant(s) is/are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant(s) is/are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571)272-0812. The examiner can normally be reached on Flexitime.

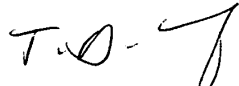
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571)272-4517. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/828,935

Page 8

Art Unit: 1639


T. D. Wessendorf
Primary Examiner
Art Unit 1639

tdw

6/2/05